

REMARKS

Reconsideration and allowance are requested.

Antecedence for the above amendments exists in the original application, for example, on page 3. No new matter has been added by the above amendments or by the present response.

Claims 1, 4, 5, 7, and 11-20 are patentable under 35 U.S.C. 103(a) over Yamashita (JP 06128121 A) and Aizawa et al (JP 58079912 A) in view of Shibata et al. (JP 08310939 A) or in view of Larsen et al. (U.S. Publication No. 2005/0113293).

The present claims define a composition comprising deep sea fish extract comprising protein and rooibos in specific percentages which is neither taught nor suggested by the references either individually or in combination.

The Examiner relies on Yamashita as teaching *Aspalathus linearis* and Aizawa as teaching extract of deep-sea fish. However, Aizawa expressly teaches fish oil from between the fish skin which has nothing to do with deep-sea fish extract. Contrary to the Examiner's contention, fish extract is not fish oil. Fish extract comprises parts of the fish not limited to fish oil extracted from the skin. Thus, the combined teachings of Yamashita and Aizawa will provide *aspalathus linearis* and fish oil that has nothing to do with the claimed fish extract. There is no teaching, suggestion or even a remote hint in either of the two references to equate fish extract and fish oil.

The Examiner's rejections are all based on precisely an "obvious to try" holding which has been repeatedly reversed by the Courts. A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art (emphasis supplied) is not sufficient to

establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). ***" [R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

The Examiner does not provide any reasoning for why one of ordinary skill in the art would be motivated to use Yamashita and Aizawa and arrive at the claimed invention. Moreover, nothing in the entireties of each of those references teaches or suggests a combination of the two or the features as claimed in the present claims.

Since Yamashita and Aizawa do not teach or suggest the claimed invention, any further combination with other references will also lead away.

Shibata has been relied on for horsetail extract. It is apparent that the Examiner has picked Shibata using the present invention teaching as a guide for hindsight reconstruction. Nothing in Yamashita and Aizawa teach the necessity of skin whitening agent. Nothing in Shibata teaches the need for the Yamashita moisturizing of the skin or Aizawa's moistening/smoothing of the skin. The present invention teaches a unique combination that has been relied on by the Examiner to pick and choose individual elements from references to deprecate the claimed invention. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 USPQ2d 1783, 1784 (Fed. Cir. 1992), quoting from *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). "This court has previously stated that one cannot use hindsight

reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." Id. quoting from *In re Fine*, 5 USPQ2d 1600 (Fed. Cir. 1988).

Since Yamashita and Aizawa do not teach or suggest the claimed invention, any further combination with other references will also lead away.

Larsen has been relied on as teaching alkaloid boldine. Larsen uses the alkaloid boldine with other compounds for treating different ailments in middle aged and elderly people. The claimed diacetyl boldine works via α -adrenergic antagonist receptors and calcium flow regulation and is not described, taught or suggested by Larsen.

Moreover, nothing in any of the references teach or suggest a combination as effected by the Examiner. The mere fact that references can be combined or modified does not render the resultant combination obvious unless ****>**the results would have been predictable to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007).

Furthermore, it is respectfully submitted that the Examiner has not produced a *prima facie* case of obviousness for at least Claims 2-5, 7, and 11-20 for the additional reason that the limitations of those claims have not been addressed. It should not be left to the Applicant to attempt to reason how the rejection of claim 1 might apply to the dependent claims as it would be based on assumptions and conjecture.

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 25 USPQ2d 1443, 1447 (Fed. Cir. 1992) citing *In re Grabiak*, 226 USPQ 870, 873 (Fed. Cir. 1985). The office action does not provide any basis for the rejection of each of the features in every claim and therefore applicant is unable to determine Examiner's basis for the rejection of each of the

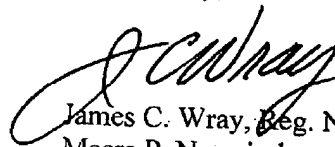
claims to adequately rebut the rejections. Therefore, as dictated by Oetiker "without more applicant is entitled to grant of the patent."

For these additional reasons, and for the reasons set forth regarding the rejection of Claim 1, the rejection of the Claims 2-5, 7 and 11-20 under 35 U.S.C. 103(a) is also improper, and should be withdrawn.

CONCLUSION

Reconsideration and allowance are respectfully requested.

Respectfully,



James C. Wray, Reg. No. 22,693
Meera P. Narasimhan, Reg. No. 40,252
1493 Chain Bridge Road, Suite 300
McLean, Virginia 22101
Tel: (703) 442-4800
Fax: (703) 448-7397

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